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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/487,392	01/18/2000	Leonard H. Lopez Jr.	1036.1140	3110

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EXAMINER
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ZURITA, JAMES H

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 11/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/487,392

Applicant(s)

LOPEZ JR., LEONARD H.

Examiner

James H Zurita

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 4-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 4-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 January 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Amendment***

Applicant amendment of 23 August 2004 added claims 25-31.

Claims 1, 4-31 are pending and will be examined.

### ***Response to Arguments***

Applicant attempts to overcome the rejection based by disqualifying Klatt as prior art with an affidavit under 37 CFR 1.131 is not effective for reasons explained below.

### ***Affidavit under 37 CFR 1.131***

The affidavit/declaration of Leonardo H. Lopez Jr. filed on 23 August 2004 under 37 CFR 1.131 has been considered but is ineffective to overcome the Klatt reference.

### **Failure to establish diligence**

The evidence submitted is insufficient to establish diligence from a date prior to the date of reduction to practice of the Klatt **reference** to either a constructive reduction to practice or an actual reduction to practice. In the present case, the applicant's have not properly established diligence through sketches, notebook entries, etc. for the entire time from prior to the date of the Klatt reference up to the date of reduction to practice. "An applicant must account for the entire period during which diligence is required." *Gould v.*

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*Schawlow*, 363 F.2d 908, 919, 150 USPQ 634, 643 (CCPA 1966). Statements that the subject matter “was diligently reduced to practice” is not a showing “but a mere pleading.” *In re Harry*, 333 F.2d 920, 923, 142 USPQ 164, 166 (CCPA 1964). Diligence requires that Applicants must be specific as to dates and facts. *Kendall v. Searles*, 173 F.2d 986, 993, 81 USPQ 363, 369 (CCPA 1949). (Also see MPEP 2138.06).

#### Lacks NAFTA/WTO allegation

The affidavit or declaration must contain an allegation that the acts relied upon to establish the date prior to the reference or activity were carried out in this country or in a NAFTA country or WTO member country. (See MPEP 715.07(c) and 35 U.S.C. 104).

#### Failure to establish conception

The evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the Klatt reference. While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897). In the present case, applicants have not properly supported conception of their invention through sketches, notebook entries, programming code, high-level system diagrams, use cases, etc.

Failure to reduce to practice (Actual)

The evidence submitted is insufficient to establish a reduction to practice of the invention in this country or a NAFTA or WTO member country prior to the effective date of the Klatt reference. An actual reduction to practice requires a showing of the invention in a physical or tangible form that shows every element of the count. See *Wetmore v. Quick*, 536 F.2d 937, 942, 190 USPQ 223, 227 (CCPA 1976). For an actual reduction to practice, the invention must have been sufficiently tested to demonstrate that it will work for its intended purpose, but it need not be in a commercially satisfactory stage of development. If a device is so simple, and its purpose and efficacy so obvious, construction alone is sufficient to demonstrate workability. *King Instrument Corp. v. Otari Corp.*, 767 F.2d 853, 860, 226 USPQ 402, 407 (Fed. Cir. 1985); (Also see MPEP 715.02 and 715.07) In the present case, the evidence submitted by the applicants fails to show the claimed limitations of internet-accessible interfaces, including selected web page flows that clearly illustrate, for example, that a requestor interface does not enable a user to modify typography. Additional evidence may be provided in the form of test results for unit testing, string testing, user acceptance testing, production testing. For example, such results may include hash totals, number of input records, expected output, correction of detected errors, etc. for each of unit test region, UAT region, production region. In contrast, the documents fail to show web page flows for internet profile management interfaces accessible to selected institutional representatives.

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There is no provision of results for testing accessibility restrictions to various levels of users, for example.

Lacks Signature or Punishment Paragraph

The affidavit submitted by the applicants is defective because the clause regarding "willful false statements..." required by 37 CFR 1.68 has been omitted.

Lack of Drawings and/or Explanation

37 CFR 1.131(b) states "Original exhibits of drawings or records, or photocopies thereof, must accompany and form part of the affidavit or declaration or their absence satisfactorily explained." In the present case, the Applicants have neither provided the Patent Office with drawings, records, or photocopies for use cases, entity relationship diagrams, load balancing considerations and tradeoffs, traffic analysis, database normalization steps, etc., nor have they satisfactorily explained the absence of such documents.

For these reasons, the declarations are rejected.

***Drawings***

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the Print provider interface (claims 30, 31), Order-approval interface (claims 28, 29), Profile management interface (claim 26) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

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Corrected drawing sheets are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action.

The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 25-31 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

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- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

It is noted that certain claims appear to recite technology, but the technology is involved in a trivial manner. The first two steps of claim 31, however, can be accomplished with paper and cutting tools.

Other claims contain nonfunctional descriptive material. For example, the language "...wherein the user is a previously registered user of a World Wide Web site..." merely describes inferential activities that are not involved in an active sense. As such, the descriptive material imparts little patentable moment in distinguishing the instant method from that of the prior art.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.



Claims 26 and 28-31 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The disclosures provide no description of the Print provider interface (claims 30, 31), Order-approval interface (claims 28, 29), Profile management interface (claim 26) must be shown or the feature(s) canceled from the claim(s).

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1, 4-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Klatt et al. (US 6,473,760) in view of ImageX.com **SEC Filing** of 12 May 1999, downloaded from [www.secinfo.com](http://www.secinfo.com) on 10November 2004.

The Examiner respectfully notes that he cites particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that, in preparing responses, the applicant fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

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Klatt discloses methods and systems for fulfillment of institutional business card and stationery product orders, including the steps of:

***Providing*** a set of printable stationery products. See, for example, references to business-cards and other stationery products, at least in Col. 1, lines 16-27, Col. 11, lines 8-19).

***Customizing and generating a company-tailored prototypical product record*** comprising one or more template(s) (e.g., item 1504) to define informational elements and the placement and typography for printing a stationery product (such as a business card or envelope). See, for example, Fig. 6 and related text and references to schemas and records tailored to Company-X and to Company-Y. Each record may contain information tailored to a particular institution. Company-tailored prototypical product records may consist of templates to define placement and typography of a plurality of informational elements for printing on a company-tailored business card or stationery product. See, for example, references to pre-defined business card styles for particular establishments, at least in Col. 7, lines 48-67. See also Col. 19, lines 42-54, which shows that formatting information, such as shape, color and other parameters of a business card may be specified for each type of a business card in an establishment. See also references to company tailored product records that may be generated for particular occasions, including special sets of business cards and stationery items, at least Col. 11, lines 8-19.

***Collecting and providing Informational elements and content*** – For example, see, at least references to event data, Col. 5, lines 43-55. See fields

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list, for example, Fig. 6. For company-indicative informational elements, including at least one of which identifies a specific organization, see at least references to title, name of company, etc., Col. 10, line 42-Col. 11, line 19. For user-indicative information, see references to employee name or title of the employee, for example. For graphical representation of business organization logos, see at least Col. 8, line 60-Col. 9, line 13.

**Order entry-** providing a requestor interface for entry of a distributed user's print order. See, for example, references to a user creating an order for a print product using ordering computers, at least Col. 1, lines 30-53. See also references to creating orders for print products, at least Col. 11, lines 8-60.

**Selecting and ordering** - Adapting requestor interface(s) to enable a user to select and order company-tailored prototypical product record for a business card to be printed according to the company-tailored product record and contents (such as stored in the schema records see in Fig. 5, for example, employee name) of a profile (applicant's predeterminable profile).

**directly generating** a pre-press product automatically merging and incorporating the profile data into the tailored product. See, for example, references to imaging setting systems and interfaces. Image setters (item 110, for example) and imaging systems (item 208, for example) are devices that generate plates or other medium (binary instruction sets and command sets) that can be **automatically generated** and **directly** used by a printing press to produce a printed product. See at least Col. 1, lines 53-64, Col. 7, lines 7-19.

Klatt discloses that users may use interfaces for defining first sets of rules, i.e., prototypical rules, such as for new employees, for example, Col. 2, lines 56-63. Klatt discloses the use of various interfaces for generating one or more of a plurality of company-tailored prototypical product records (such as a record for a business card, for example, or record for envelopes, or other type of stationery, see for example, Col. 11, lines 28-63). Each record may contain a list of fields. Generating each company-tailored prototypical product records may **comprise** defining a plurality of informational elements including fields (such as employee name field, employee title field, in Fig. 6, for example). These fields are adapted to be filled with content defined by a plurality of profiles (for example, creating lists of new employees, at least Col. 5, lines 6-55).

Klatt does not specifically disclose that a requestor interface may comprise a server-side scripting environment (claim 13). Klatt discloses that monitors and event detectors may be located on either client side or server side. See, for example, Col. 8, lines 12-59. Klatt discloses that software may be tailored to a company's database server, whose data can be sent over the Internet to a print facility. Editing and validation may be done on a server-side or on a client-side. As noted previously, these and other functions may be executed with scripting languages. As applicant admits, scripting environments are well known to persons of ordinary skill in the art (see application, page 5, lines 7-8). In addition, scripting may be implemented with a server-side scripting language such as ACTIVE SERVER PAGES, from MICROSOFT.

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It would have been obvious to one of ordinary skill in the art at the time the invention was made to extend Klatt to include a server-side scripting environment. One of ordinary skill in the art at the time the invention was made would have been motivated to extend Klatt to include a server-side scripting environment for the obvious reason that on the Web, scripts are commonly used to customize or add interactivity to Web pages, and permits users to adapt pages to prefill some fields, for example.

Klatt **does not** disclose that pre-press product comprises a copier command set (claim 16). Klatt discloses that a printer may be selected according to various criteria, including geographical proximity, or specialization. Klatt discloses sending print orders to local print shops or copy stores. See, for example, Col. Line 30-53. It was well known to those of ordinary skill at the time the invention was made to send copier command sets to systems that produce printed products via electronic copying machines, such as may be found in a copy store. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Klatt and knowledge generally available to those of ordinary skill in the art at the time the invention was made to disclose sending pre-press product comprising copier command set to a copy store, for example.

One of ordinary skill in the art at the time the invention was made would have been motivated to combine Klatt and knowledge generally available to those of ordinary skill in the art at the time the invention was made to disclose sending pre-press product comprising copier command set to a copy store, for

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the obvious reason that copier stores may have copying machines and these copying machines may require copier command sets to produce a print product.

Klatt does not disclose that his template(s) or records or profiles contain information concerning placement, tracking, kerning and text adjustment for specific company tailored products. Klatt discloses layout computers that may be used to lay-out the content within space and style constraints of a print medium. Klatt discloses that printed products and data content for each product may be mapped to one or more fields at a print facility (which requires pre-press product, including kerning, etc.). The product prototype and template may define common fields. Similarly, formatting information may be specified, such as size, shape, and ***other parameters***. Klatt discloses the use of conventional software packages such as QUARK to perform placement, tracking, kerning and text adjustment for specific products, prior to creation of a pre-press product. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Klatt and knowledge generally available to one of ordinary skill in the art at the time the invention was made to disclose permitting users to provide other tracking information such as kerning, placement, tracking and text adjustment. See also at least Col. 15, lines 7-40.

One of ordinary skill in the art at the time the invention was made to would have been motivated to combine Klatt and knowledge generally available to one of ordinary skill in the art at the time the invention was made to disclose permitting users to provide other tracking information such as kerning, placement, tracking and text adjustment for the obvious reason that personalized

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and marketing materials often require fitting text to physical size product. A business card, for example, may use smaller size font than a letterhead. Similarly, different companies may require printing a different logo on different products. Text, position, etc. may need to be adjusted accordingly, to produce a pleasing, professional overall effect.

Klatt does not specifically disclose, as in claim 26, a profile management interface that enables an institutional representative to specify and modify institution-indicative content contained or referenced by the user profiles.

**SEC Filing** discloses control and password protected online printing center where authorized customer employees can individually modify, proof, procure and manage a wide variety of printed business materials within the centralized parameter and present rules established by the customer. See, for example, S-1 page 9 of 123,

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine *Klatt* and **SEC Filing** to disclose that an interface enables or does not enable a user to modify the typography of any information to be printed on the business card or stationery product.

One of ordinary skill in the art at the time the invention was made would have been motivated to combine *Klatt* and **SEC Filing** to disclose that an interface enables or does not enable a user to modify the typography of any information to be printed on the business card or stationery product for the obvious reason that it is important to maintain references for standard corporate design for printed matter. A company's image may be reflected by its graphic art

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for items such as logos and trademarks. It would therefore be important to restrict typography selections to overcall corporate control parameters.

*Klatt* and **SEC Filing** do not use the labels user-indicative, company-indicative, profile management interface, requestor interface, order processing interface. However, the labels applied to various actors, nodes, interfaces, etc., are not functionally related to the substrate of the article of manufacture. Thus, this descriptive material does not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to apply a label to various actors and modules in a system such as *Klatt* and **SEC Filing** because such labels do not functionally relate to the substrate of the article of manufacture and merely labeling the data differently from that in the prior art would have been obvious. See *Gulack* cited above.

*Klatt* and **SEC Filing** do not classify various functions according to applicant's most recent redistribution of functions among various interfaces, such as processor interface, a purchaser interface and a requestor interface. It would have been obvious to one of ordinary skill in the art at the time the invention was made to classify various functions according to various interface(s), such as processor interface, a purchaser interface and a requestor interface, since it has



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been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

One of ordinary skill in the art at the time the invention was made would have been motivated to classify various functions according to various interface(s), such as processor interface, a purchaser interface and a requestor interface, for the obvious reason that it is important to design a system and assign functions according to who (which actors) will be performing particular functions and provide various interfaces to facilitate use of the computer.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

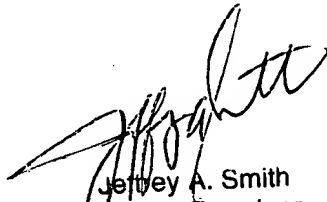
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to James H Zurita whose telephone number is 703-605-4966. The examiner can normally be reached on 8a-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 703-308-1344. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*JZ*  
**James Zurita**  
**Patent Examiner**  
**Art Unit 3625**  
11 November 2004

  
**Jeffrey A. Smith**  
**Primary Examiner**